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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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BEYER WEAVER LLP P.O. BOX 70250 OAKLAND, CA 94612-0250			EXAMINER DUFFY, DAVID W	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 06/14/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/783,122	<b>Applicant(s)</b> SHELBY ET AL.	
	<b>Examiner</b> David W. Duffy	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/23/2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02/19/2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____  |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :02/19/2004, 07 /26/2004, 11/30/2004, 07/05/2005, 08/31/2005, 10/23/2006.

## **DETAILED ACTION**

### ***Priority***

1. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).
2. The disclosure of the prior-filed application, Application No. 60/326030, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The provisional application provides no support for encryption or digital signatures. The later filing date of Application No. 10/256949 provides support for the currently pending claims and will be used for the priority date.

### ***Information Disclosure Statement***

3. The information disclosure statements filed 07/26/2004 and 10/23/2006 fail to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. They have been placed in the application file, but the foreign and non-patent literature information referred to therein has not been considered.

***Drawings***

4. The drawings are objected to because figure 2 has a decision block with no branches and the overall flow chart does not match the description provided in the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 18E, 46, 48 and 64. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action

to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "60" has been used to designate both receiving command step and verified signature check. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Specification***

7. The disclosure is objected to because of the following informalities: Pg 4, line 27: "slaver" should be slave. Pg 5, line 23: "multiplies this times" is redundant. Suggested

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correction is "multiplies this by". Pg 7, line 31: "communication ... were lost" is incorrect.

Suggested correction is "communication ... was lost".

Appropriate correction is required.

8. The use of the trademarks RANDOM REWARDS, CELEBRATION PRIZES and XTRA CREDIT has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

#### ***Claim Objections***

9. Claim 6 is objected to because of the following informalities: "further comprises comprises" is redundant. Suggested correction is "further comprises". Appropriate correction is required.

10. Claim 8 is objected to because of the following informalities: The claim recites the limitation "the bonus command". There is insufficient antecedent basis for this limitation in the claim. Examiner assumes applicant intended to have "a bonus command" and is examining as such. Appropriate correction is required.

11. Claim 9 is objected to because of the following informalities: "to a one electronic gaming machine" is redundant and improper. Suggested correction is "to one electronic gaming machine". Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim cites the limitation that the gaming machine re-hashes the command. The specification does not disclose the gaming machine doing anything beyond verifying the received command. A close reading of the specification only seems to disclose that the slave server ever verifies and re-hashes a command.

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1-3 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Nguyen (USPN 7127069).

16. In regards to claim 1, Nguyen discloses generating a command based on an event at a gaming machine, digitally signing it and transmitting to a receiving node for re-hashing and verification (fig 4, elements 400-420).



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17. In regards to claim 2, Nguyen discloses that the gaming machine generates encrypted data messages based on machine transactions (fig 4, elements 400-406).

Examiner contends that this constitutes monitoring events to generate a command.

18. In regards to claim 3, Nguyen discloses that the remote server or master of the system receives messages from the gaming machine and responds to the message (fig 4, elements 426-431). Examiner contends that this constitutes monitoring events on the gaming machine by the master server as it receives event information from the gaming machine thereby monitoring the event. Nguyen further discloses that the local server or slave receives the signed command (fig 4, element 408).

19. In regards to claim 8, Nguyen discloses that encryption may be optional over a dedicated communication network and then applied when the message reaches an unsecured channel (11:39-47)

***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 4 and 16-19 rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen (USPN 7127069).

22. In regards to claim 4, Nguyen discloses that the slave server processes and stores data generated by the gaming machine before re-encrypting and sending it to the

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master server (fig 4, element 412). Examiner contends that by storing the data the slave server is inherently monitoring the activities of the gaming machine. Nguyen further discloses sending a command from the master server to the gaming machine that the gaming machine verifies (fig 6). Nguyen seems to lack explicitly stating that the gaming machine re-hashes the command after receiving it.

23. However, it is known in the art of computer security to store licenses and game data in an encrypted format, and by having the game machine sign the data it would be possible to determine what gaming machine an illegally obtained license was taken from.

24. In regards to claims 16 and 17, Nguyen discloses the receiving of commands with digital signatures and verifying the signatures at a slave device (12:60-13:3). Nguyen seems to lack explicitly stating that the command would only be executed if the verification is good.

25. However, it would be extraordinarily obvious to not execute commands from unauthorized system as such it would be an obvious modification to make to not execute commands from systems where the signature was invalid.

26. In regards to claim 18, Nguyen discloses that the gaming device may receive signed messages and validate them (16:23-27)

27. In regards to claim 19, Nguyen discloses generating a signed command at the master server, sending it to the slave server, and the slave server decrypting the message and forwarding to the gaming machine (13:56-14:11).

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28. Claims 5-7 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen in view of Torango et al. (USPN 5885158).

29. In regards to claims 5 and 6, Nguyen discloses a system that is used to replace dedicated casino networks with secure communications over a general use network (3:61-4:7). Nguyen further discloses that some of the dedicated casino networks that may be replaced include network services for bonus game play, progressive game play and cashless ticketing (2:35-49). Nguyen seems to lack explicitly stating that a bonus would trigger a message to be sent.

30. In a related networked casino system, Torango discloses a bonus system that generates bonus commands (15:41-51). One skilled in the art would recognize the advantages of providing progressive games on a networked system to increase the size of the contributing player pool.

31. Therefore it would have been obvious to one skilled in the art at the time to combine the secure system of Nguyen with the progressive system of Torango to provide a secure progressive system.

32. In regards to claim 7, Nguyen discloses generating a signed command at the master server, sending it to the slave server, and the slave server decrypting the message and forwarding to the gaming machine (13:56-14:11). Nguyen seems to lack explicitly stating that the message is a bonus command.

33. In a related networked casino system, Torango discloses a bonus system that generates bonus commands (15:41-51). One skilled in the art would recognize the

advantages of providing progressive games on a networked system to increase the size of the contributing player pool.

34. Therefore it would have been obvious to one skilled in the art at the time to combine the secure system of Nguyen with the progressive system of Torango to provide a secure progressive system.

35. Nguyen in view of Torango seems to lack explicitly stating that the reply message is re-signed before sending it to the gaming machine.

36. However, Nguyen already discloses signing the messages on the way to the slave server from the gaming device (fig 4) and discloses that the slave server decrypts and then forwards the message to the gaming machine as stated above. It would be obvious to also re-encrypt and sign the message before sending it to the gaming machine as suggested by Nguyen.

37. In regards to claim 20, Nguyen discloses the system as described above for claim 16. Nguyen seems to lack discloses that the command comprises paying a bonus at a gaming machine.

38. In a related networked casino system, Torango discloses a bonus system that generates bonus commands including paying a bonus (15:41-51). One skilled in the art would recognize the advantages of providing progressive games on a networked system to increase the size of the contributing player pool.

39. Therefore it would have been obvious to one skilled in the art at the time to combine the secure system of Nguyen with the progressive system of Torango to provide a secure progressive system.

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40. Claims 9-15 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torango et al. (USPN 5885158) in view of Nguyen.

41. In regards to claim 9, Torango discloses a progressive bonus system where the central server generates bonus commands (15:41-51). Torango further discloses the use of verification of hardware identification (16:1-13). Torango seems to lack the use of encryption and signed commands.

42. In a related network casino system, Nguyen discloses a system that is used to replace dedicated casino networks with secure communications over a general use network (3:61-4:7) where commands are digitally signed and transmitted to a gaming machine (13:56-14:11). Nguyen further discloses that some of the dedicated casino networks that may be replaced include network services for bonus game play, progressive game play and cashless ticketing (2:35-49). One skilled in the art would recognize the advantages of providing network security features to a networked progressive game system.

43. Therefore it would have been obvious to one skilled in the art at the time to combine the security system of Nguyen with the bonus system of Torango in order to provide a secure bonus system.

44. In regards to claim 10, Torango discloses monitoring gaming machine play (5:32-44).

45. In regards to claim 11, Torango discloses determining if a machine is to receive a bonus (15:41-51).

46. In regards to claims 12, Torango discloses the central server generating a bonus command (13:56-14:11)

47. In regards to claim 13, Torango discloses that the slave server monitors communication and provide verification of prize wins (16:1-23). Torango seems to lack explicitly disclosing that the slave server generates the bonus command. However, it is well known in the art of network systems to have mirrored servers doing the same tasks to compensate for any network outages or problems. As such, it would have been an obvious modification to provide the slave server with the ability to handle bonus commands on its own in the even that the central server was unreachable.

48. In regards to claim 14, Torango discloses that the bonus commands are sent to the game machine through the cluster controller. Torango seems to lack explicitly stating that the messages are signed.

49. In a related networked casino system, Nguyen discloses generating a signed command at the master server, sending it to the slave server, and the slave server decrypting the message and forwarding to the gaming machine (13:56-14:11). One skilled in the art would recognize the advantages of providing secure messages for a financial transaction system on an unsecured network.

50. Therefore it would have been obvious to one skilled in the art at the time to combine the bonus system of Nguyen with the security system of Torango in order to provide a secure bonus server. The combination made seems to lack explicitly stating that the reply message is re-signed before sending it to the gaming machine.

51. However, Nguyen already discloses signing the messages on the way to the slave server from the gaming device (fig 4) and discloses that the slave server decrypts and then forwards the message to the gaming machine as stated above. It would be obvious to also re-encrypt and sign the message before sending it to the gaming machine as suggested by Nguyen.

52. In regards to claim 15, Torango discloses a progressive bonus system where the central server generates bonus commands (15:41-51). Torango further discloses the use of verification of hardware identification (16:1-13). Torango seems to lack the use of encryption and signed commands.

53. In a related network casino system, Nguyen discloses a system that is used to replace dedicated casino networks with secure communications over a general use network (3:61-4:7) where commands are digitally signed and transmitted to a gaming machine (13:56-14:11). Nguyen further discloses that encryption may be optional over a dedicated communication network and then applied when the message reaches an unsecured channel (11:39-47). One skilled in the art would recognize the advantages of providing network security features to a networked progressive game system.

54. Therefore it would have been obvious to one skilled in the art at the time to combine the security system of Nguyen with the bonus system of Torango in order to provide a secure bonus system where needed.

55. In regards to claim 21, Torango discloses a bonus server system that pays bonuses to players as directed (15:41-51) and further discloses that the gaming machines are verified by machine signatures and if invalid the bonus is canceled (16:4-

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15). Torango seems to lack explicitly discloses the use of digital signatures and their verification.

56. In a related network casino system, Nguyen discloses a system that is used to replace dedicated casino networks with secure communications over a general use network (3:61-4:7) where commands are digitally signed and transmitted to a gaming machine (13:56-14:11). One skilled in the art would recognize the advantages of providing network security features to a networked progressive game system.

57. Therefore it would have been obvious to one skilled in the art at the time to combine the security system of Nguyen with the bonus system of Torango in order to provide a secure bonus system and to ensure that payout commands are from authorized systems only.

58. In regards to claim 22, Torango discloses manual intervention to resolve invalid payouts (16:15-21).

59. In regards to claim 23, Torango discloses that the bonus commands are sent to the game machine through the cluster controller. Torango seems to lack explicitly stating that the messages are signed.

60. In a related networked casino system, Nguyen discloses generating a signed command at the master server, sending it to the slave server, and the slave server decrypting the message and forwarding to the gaming machine (13:56-14:11). One skilled in the art would recognize the advantages of providing secure messages for a financial transaction system on an unsecured network.



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61. Therefore it would have been obvious to one skilled in the art at the time to combine the bonus system of Nguyen with the security system of Torango in order to provide a secure bonus server. The combination made seems to lack explicitly stating that the reply message is re-signed before sending it to the gaming machine.

62. However, Nguyen already discloses signing the messages on the way to the slave server from the gaming device (fig 4) and discloses that the slave server decrypts and then forwards the message to the gaming machine as stated above. It would be obvious to also re-encrypt and sign the message before sending it to the gaming machine as suggested by Nguyen.

### ***Conclusion***

Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

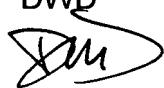
Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

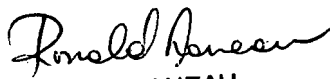
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David W. Duffy whose telephone number is (571) 272-1574. The examiner can normally be reached on M-F 0800-1630.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DWD  


  
RONALD LANEAU  
PRIMARY EXAMINER

6/8/07